

REMARKS

Entry of the amendment is respectfully requested since it would either lessen the issues on appeal or avoid the need for an appeal. Reconsideration is respectfully requested in light of the foregoing Amendment and remarks that follow.

Claims 3-8 are before the Examiner. (Claim 9 was canceled in the previous response.) Claims 3 has been amended to address the objections to the claims and to address points raised in the rejections.

The objection to the specification has been considered. It appears that "A" in both instances are typos. It is clear that "H" was intended. Applicants will make the appropriate corrections upon an indication of allowable subject matter. It is respectfully requested that this requirement be held in abeyance until that time.

The objection to the claims has been addressed by the amendment to claim 3. Please note that the "dash" was a coping artifact. This has been addressed. With regard to the second "Y=", it has been deleted and the "second" line of alternatives has been included with the first to improve clarity.

Claim 3-9 [8] are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse in light of the amendments to the claims. Applicants respectfully traverse.

The value range for "x", which has been at issue, has been deleted from the claims along with the related formula. This was done solely to advance prosecution. In light of the deletion of the formula along with the range for "x", the rejection is rendered moot. Withdrawal of the rejection is respectfully requested.

Claims 3, 4, and 6-9 [8] are rejected under 35 U.S.C. 103(a) as being unpatentable over Deller et al (5,776,240) in view of Mangold et al. (CA 2,223,377). Applicants respectfully traverse.

The product according to the invention has the advantage that it can be worked into organic systems, e.g. polyester resin (see p. 13 of the specification) more rapidly and in a higher concentration. This advantage is not disclosed by Deller et al.

Further, Deller et al. disclose granules based on pyrogenically produced silicon dioxide, which shows a particle size of 10 to 120 μm . These granules can be surface-modified. The principal utility mentioned by Deller et al. for the granules is as catalyst supports. Deller et al. mention the use of some pyrogenically produced silicas in column 6 as educts. There is no disclosure or suggestion of the combination of a pyrogenically produced oxide doped by an aerosol and surface modification.

Mangold et al. disclose pyrogenically produced oxides doped by an aerosol. However, Mangold et al. do not disclose a surface modified pyrogenically produced oxides doped by an aerosol. While Mangold et al. do disclose a thickening effect, there is no suggestion or recognition of the advantage taught for applicants' product appearing on page 13 of the specification, e.g. higher concentrations and "rapidity" of work in.

The Examiner urges that it would be obvious to combine the surface treatment and the pyrogenically produced oxides doped by an aerosol and arrive at the product as claimed. The references on their face do not suggest their combination. Further, it is not clear if the references suggest that the benefits of each can be realized if the references are combined. Applicants' disclosure is not available as a reference in this regard.

It is respectfully submitted that a prima facie case has not been established. Further, if the Examiner still deems that a prima facie case exists, Dr. Jürgen Meyer, one of the applicants, has performed some experiments, which show the advantage of the pyrogenically produced

silica doped with potassium by an aerosol having been worked in a LSR-silicon-rubber. The experimental work described in German (Exhibit I) and a translation (Exhibit II) are included. (These results can be placed in a Rule 132 Declaration if the Examiner wishes. The advantages are not suggested by the references. See translation at page 10 where Examples 5 and 6 are reported as showing easy intermingling, an extremely good wettability and also low rheological properties for products of the invention. See Table 5. In addition note Table 6, where extraordinary high transparency and high resistance to tear are also reported for silicone rubber containing the product of the invention.

In light of these results, there are additional reasons to withdraw the rejection since the claimed products have surprising and beneficial characteristics not expected from the art of record and should be considered as rebutting a prima facie case.

Claims 3, 5, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Läufer et al. (4,022,152) in view of Mangold et al. (CA 2,223,377). Applicants respectfully traverse.

Läufer et al. (Example 1) disclose a pyrogenically produced silicon oxide treated with D₄ (octamethyltetrasiloxane). Läufer et al. do not disclose a surface modified pyrogenically produced oxide doped by an aerosol.

Mangold et al. disclose pyrogenically produced oxides doped by an aerosol. Mangold et al. do not disclose or suggest surface modification of its pyrogenically produced oxides doped by an aerosol. Mangold et al. do not disclose the advantages of applicants' product appearing on page 13 of the specification (higher concentrations and ease of dispersibility). These advantages are distinct from the thickening effect described by Mangold et al.

The Examiner's position is that it would be obvious to modify Läufer et al. product by substituting a pyrogenic dioxide for silicon dioxide. It is not clear at the outset that the properties

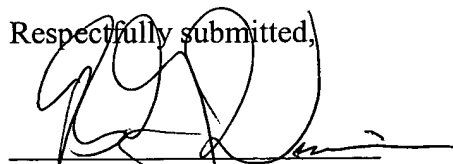
originally possessed by either Mangold et al.'s product or Läufer et al. would be maintained in the proposed composite. Applicants' specification is not available as a reference in that regard.

In any event, should a prima face be thought to have been established, it is respectfully submitted that the results discussed above be considered as rebutting such a case.

In view of the foregoing amendments and remarks, the application is believed to be in condition for allowance and a notice to that effect is respectfully requested.

Should the Examiner not find the Application to be in allowable condition or believe that a conference would be of value in expediting the prosecution of the Application, Applicants request that the Examiner telephone undersigned Counsel to discuss the case and afford Applicants an opportunity to submit any Supplemental Amendment that might advance prosecution and place the Application in allowable condition.

Respectfully submitted,



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DC2-DOCS1-619264